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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,957	04/02/2004	Naoyuki Kawanishi	Q80132	8928
23373	7590	12/15/2004	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			CHEA, THORL	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,957

Applicant(s)

KAWANISHI ET AL.

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/893,750.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04022004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 23-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the term "obtaining" and "providing" in claims 1 in (a), (b); claim 27, in (a), (b); claim 36 in (b) renders the claimed invention indefinite since the term "providing" and "obtaining" fails to clearly described the actual steps as how the process should be performed. In claim 23, 27, 36 step (a) is related to the process of forming silver salt of an organic acid used in the production of a thermally processed image forming material. The process for forming thereof is separate from that of the process of forming the thermally processed image forming material. Therefore, the scope of protection sought of the processing step in step (a) is unclear whether it was intended to claim the step (a) of forming a silver salt of an organic acid as part of the process of forming a thermally processed image forming material or otherwise.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 23-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to teach as how to incorporate the step of (a), steps of providing or forming the silver salt of an organic acid to be part of the processing steps of forming a thermally processed image recording material. claimed in the present claimed invention. See for instance the preparation of thermally processed image forming material on pages 126-127 wherein the step (a) as of the claimed invention is not included therein.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 23-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Yasuda (US Patent No. 6,783,925).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

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See process disclosed in Examples in columns 58-82, especially the process for forming a silver salt of a fatty acid and in Example 1, Table 61 in columns 61-62, and the process for providing the an image forming layer on a support in column 66, lines 50-69; the process using ultra-filtration and in column 10, and high pressure dispersion apparatus in the abstract, and column 6, lines 35-48. Yasuda considered as a whole disclosed the process for forming a material as claimed, and therefore, the invention as claimed lacks novelty.

7. Claims 23-42 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 1069468 (EP'468). See the process for fabricating the photothermographic material on page 18, [0133], and the method for forming the silver salt of an organic acid using a closed mixing mean on pages 20-21. See also the document as a whole. The EP'468 discloses a process having step as claimed, therefore anticipated the claimed invention.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 23-42 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP'1063566 (EP'566).

See the process for fabricating a heat-developable material on page 28, [0226] to [0227] which comprises the step of providing a image forming layer containing silver salt of an organic salt, a reducing agent and binder on a support to fabricate a heat developable material. The EP'566 may not disclose process for forming silver salt of an organic acid in a sealed mixing means claimed in the present claimed invention. However, the step (a) presented in the claimed invention is directed to the process of forming a silver salt of an organic acid, which is separate process from that of the process of forming a material. Therefore, the invention as claimed is related to claiming a process of a forming a thermally processed image recording material by a process of forming a silver salt of an organic acid. However, the process for providing an imaging layer on a support are the same as taught in the prior art of record. In the absence of showing the criticality of the process of forming the silver salt of an organic acid in the process of forming the a thermally processed image recording material, it is asserted that the invention as claimed is either anticipated or found prima facie obvious over the prior art of record.

11. Claims 23-42 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0962812 (EP'812).

See the process for fabricating a heat-developable material on page 32, [0252] to [0253] which comprises the step of providing a image forming layer containing silver salt of an organic salt, a reducing agent and binder on a support to fabricate a heat developable material. See the document as a whole. The EP'566 may not disclose process for forming silver salt of an organic acid in a sealed mixing means claimed in the present claimed invention. However, the step (a)

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presented in the claimed invention is directed to the process of forming a silver salt of an organic acid, which is separate process from that of the process of forming a material. Therefore, the invention as claimed is related to claiming a process of a forming a thermally processed image recording material by a process of forming a silver salt of an organic acid. However, the process for providing an imaging layer on a support are the same as taught in the prior art of record. In the absence of showing the criticality of the process of forming the silver salt of an organic acid in the process of forming the a thermally processed image recording material, it is asserted that the invention as claimed is either anticipated or found prima facie obvious over the prior art of record.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

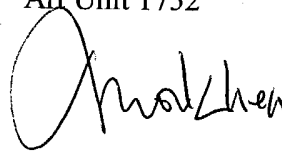
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea *TUN*
December 10, 2004

Thorl Chea
Primary Examiner
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A handwritten signature in black ink, appearing to read 'Thorl Chea', is written over the printed name and title.